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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,150	11/02/2001	Shell Sterling Simpson	10008212-1	7884

EXAMINER	
FADOK, MARK A	

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3625	

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/003,150

Applicant(s)

SIMPSON ET AL.

Examiner

MARK FADOK

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on BPAI decision 8/25/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 11-13 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11-13 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Re-Opening of Prosecution After Decision By BPAI

The Examiner in receipt of the "Decision on Appeal" (BPAI Decision on Appeal No. 2007-0781) mailed September 19, 2007. The Examiner has carefully considered the Board's decision and agrees with the conclusions provided as the basis for remanding the application back to the Examiner for further consideration (see BPAI Decision, beginning at page 10).

New rejections of claims 1-4, 7, 11-13, and 30 are provided below. Such rejections incorporate the determinations of obviousness under 35 USC 103(a) as set forth as the basis for the remand. Since many of the Board's conclusions are based upon what is considered "well-known" in the prior art, the Examiner, in support of such conclusions, has provided (herein) the appropriate evidence in support thereof.

Examiner's Note

The Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7, 11, 13 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle (6,924,878) in view of Motamed (US 6,356,359) and further in view of Van Der Linden (US 7,072,059).

Regarding claim 1: Garfinkle discloses a method for facilitating pay printing (Abstract), the method comprising:

Garfinkle teaches a method for paying for print services (fulfillment centers) that receive stored images from a central location and process the image to provide a visual print for delivery to the customer (col 3, line 55 to col 4, line 10).

However, as noted by the BPAI, Garfinkle does not teach a networked based printing service that receives scaled down versions of a full sized document to be printed from at least one store via a network. Moreover, and as noted by the BPAI, Garfinkle does not teach determining printing costs based upon attributes of a scaled down version.

The Board concluded that these features are nonetheless old and well known in the art.

Now comes Motamed. Motamed, in the print job costing art, teaches receiving a reduced resolution (thumbnail) image that can be used to estimate toner usage on a particular printer remote from a server that stores high resolution images (FIG 8, FIG 9, col 4, lines 56-63, col 5, lines 10-18, col 3, line 64 to col 4, line 25).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Garfinkle to have included a networked based printing service that receives scaled down versions of a full sized document to be printed from at least one store via a network, because this would have been recognized to have allowed for more accurate estimates being given by the print shop to a customer (Motamed: col. 3, lines 18-25).

The combination of Garfinkle and Motamed teach receiving a thumbnail to estimate costs, but does not specifically mention that the printing service retrieves the scaled down version from at least one store via a network.

Van Der Linden teaches requesting preview images by clicking on a preview button that retrieves a scaled down document such as a soft proof (Van Der Linden col 7, lines 40-60 and col 8, lines 30-55).

It would have been obvious to one of ordinary skill in that art at the time of the invention to have further modified the combination of Garfinkle and Motamed to have further included retrieving low resolution images for estimates based on reduced resolution images. This is because it takes less processing time and therefore is more efficient (Motamed, col 4, lines 1 and 2).

It is noted that each of the elements claimed is found in the prior art and that such elements would function in the combinations in the same manner as they do in the prior art references individually. Accordingly, such combination would have yielded predictable results (see Sakraida, 425 US at 282, 189 USPQ at 453). Since the independent claims only unite old elements with no change in their respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

Claim 1 further includes the limitations: "the printing service receiving print option selections" and "the printing service determining printing costs for printing the full-size document based upon attributes of the scaled-down version". Such limitations are found in Van Der Linden (at FIG 3) and Motamed (Abstract), respectively.

Regarding claim 2: The combination of Garfinkle/Motamed/Van Der Linden teaches that the at least one store comprises a graphic store and a composition store (Garfinkle: FIG 1; and Motamed: col. 4, lines 35-55).

Regarding claim 3: The combination of Garfinkle/Motamed/Van Der Linden teaches that the at least one store is associated with an imaging source with which the full-sized document is created or identified (Garfinkle: col. 9, lines 22-50; Van Der Linden, col. 9, lines 55-60).

Regarding claim 4: Garfinkle teaches that the imaging source comprises a network-based imaging service (Garfinkle: FIG 1; Van Der Linden: Abstract).

Regarding claim 7: The combination of Garfinkle/Motamed/Van Der Linden teaches that the scaled down version comprises one or more thumbnails that represent document pages (Van Der Linden: col. 2, lines 25-45; Motamed: col. 4, lines 55-62).

Regarding claim 11: The combination of Garfinkle/Motamed/Van Der Linden teaches that receiving print option selections comprises receiving user selections with a web site of the network-based printing service (Garfinkle: FIG 5D; Van Der Linder: col. 2, lines 25-45).

Regarding claim 13: The combination of Garfinkle/Motamed/Van Der Linden teaches that the determination of the printing costs is dependent upon attributes of the scaled-down version and the option selections (Garfinkle: FIG 5D; Motamed: Abstract; Van Der Linder: FIG 3).

Regarding claim 30: The combination of Garfinkle/Motamed/Van Der Linden teaches that the scaled-down version is created by a network-based imaging service with which the full-sized document was created or identified (Garfinkle: FIG 3B; Motamed, col. 4, lines 37-62).

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle; Motamed (US 6,356,359); and Van Der Linden (US 7,072,059), as applied to claim 11, and further in view of Matsubayashi (6,938,202).

Regarding claim 12: The combination of Motamed/Motamed/Van Der Linden teaches a printing service that is supported by a server, but does not specifically provide that the printing service is supported by a printing device having an embedded server.

Matsubayashi, however, teaches retrieving web pages from an embedded web server that returns a webpage for client processing (Matsubayashi: col. 5, lines 53-60).

It would have been obvious to one of ordinary skill in the art to have provided the combination of Garfinkle/Motamed/Van Der Linden to have included that the printing service is supported by a printing device having an embedded server.

It is noted that all of the elements of the cited references perform the same function when combined as they do in the prior art. Accordingly, such combination would have yielded predictable results (see Sakraida, 425 US at 282, 189 USPQ at 453. Since the independent claims only unite old elements with no change in there respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**.

The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300

[Official communications; including

After Final communications labeled

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For general questions the receptionist can be reached at

571.272.3600

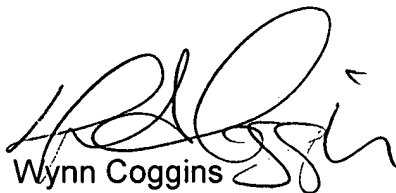
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark Fadok

Primary Examiner



Wynn Coggins
Director TC 3600